

Response

Applicant: John M. Hall et al.

Serial No.: 09/810,074

Filed: March 15, 2004

Docket No.: 10004376-1

Title: SYSTEM AND METHOD FOR IDENTIFYING INTERNAL AND EXTERNAL COMMUNICATIONS
IN A COMPUTER NETWORK

REMARKS

The following remarks are made in response to the Non-Final Office Action mailed August 19, 2005. In that Office Action, the Examiner rejected claims 1, 3, 4, 7, 9, 12, 15, 16, 18, 20, and 21 under 35 U.S.C. §103(a) as being unpatentable over Biliris et al., U.S. Patent Publication No. 2001/0009017 ("Biliris") in view of Jones, U.S. Patent Publication No. 2001/0046069 ("Jones"). Claims 5, 6, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 1 above, and further in view of Joseph et al., U.S. Patent No. 5,761,415 ("Joseph"). Claims 10 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 7 above, and further in view of Arnold, U.S. Patent No. 6,275,848 ("Arnold"). Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 7 above, and further in view of Shaw et al., U.S. Patent No. 6,247,045 ("Shaw").

With this Response, Applicant respectfully traverses the Examiner's rejection of claims 1, 3-7, 9-16, 18, 20, and 21. Claims 1, 3-7, 9-16, 18, 20, and 21 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §103 Rejections

The Examiner rejected claims 1, 3, 4, 7, 9, 12, 15, 16, 18, 20, and 21 under 35 U.S.C. §103(a) as being unpatentable over Biliris et al., U.S. Patent Publication No. 2001/0009017 ("Biliris") in view of Jones, U.S. Patent Publication No. 2001/0046069 ("Jones"). Independent claim 1 includes the limitations "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory" and "adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company." With respect to claim 1, the Examiner acknowledged that Biliris fails to teach or suggest the above-quoted limitations of claim 1, but stated that: "Jones teaches determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and

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the information in the company directory (para.[0003], [0018]), and adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company. (para.[0017]).” (Office Action at para. no. 4, page 3). Each of the three paragraphs in Jones that were cited by the Examiner are addressed below.

Jones at paragraph no. 0003 is a background paragraph that discusses “confidential” or “proprietary” documents, and discloses that “[i]t is relatively difficult and unusual for someone to inadvertently manually send such a document to an unauthorized receiver. However, the use of Internet communication changes the situation.” Jones at paragraph no. 0003 does not teach or suggest “determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory”, as recited in independent claim 1.

Jones at paragraph no. 0018 describes the email system shown in Figure 3, which includes a watermark detection and reading program 305. Jones at paragraph no. 0018 discloses that the program 305 determines if a message contains a watermark, and if the message contains a watermark, the program 305 determines whether the flag bit of the watermark is set to “confidential”, and if the flag bit is set to “confidential”, the message is returned to the sender. Jones at paragraph no. 0018 does not teach or suggest “determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory”, as recited in independent claim 1.

Jones at paragraph no. 0017 describes the data fields and flags used in a digital watermark. Jones discloses that the digital watermark is encoded into a background image by varying the width of lines contained in the background image. (See, e.g., Jones at para. no. 0016). The digital watermark disclosed in Jones is configured to be read by the watermark detection and reading program 305 (Jones at para. no. 0016), and does not appear to even provide any human readable information. Jones at paragraph no. 0017 does not teach or suggest “adding an identifier to the first network communication to indicate to recipients

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whether the first network communication is directed only to destinations internal to the company”, as recited in independent claim 1.

Thus, the paragraphs of Jones that were cited by the Examiner do not teach or suggest the above-quoted limitations of independent claim 1. Jones also discloses that a document may be stamped with the visible text “confidential”. (See, e.g., Jones at para. no. 0016). Jones discloses that such a marking indicates that the document contains confidential information. (Jones at para. no. 0003). Thus, the “confidential” marking is based on the content of the document (i.e., based on whether the document contains confidential information), as opposed to being based on destinations specified in a given communication.

There is no teaching or suggestion in Jones to add a “confidential” marking to a given email if it is determined that all destinations in the email are internal to a company. The

“confidential” marking does not indicate to recipients whether a network communication is

directed only to destinations internal to a company. Jones does not teach or suggest “adding

an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company”, as recited in independent claim 1.

In view of the above, independent claim 1 is not taught or suggested by Biliris and Jones, either alone, or in combination. Applicant respectfully requests removal of the rejection of claim 1 under 35 U.S.C. §103(a), and requests allowance of this claim.

Dependent claims 3, 4, 7, 9, and 12 further define patentably distinct claim 1, are further distinguishable over the cited references, and are believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claims 3, 4, 7, 9, and 12 under 35 U.S.C. §103(a), and requests allowance of these claims.

Independent claim 15 includes the limitation “a controller configured to perform a search of the directory server based on the received destination information, determine whether the destination information specifies a destination that is internal to a first company based on the search, and add an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the first company.” The Examiner stated that “claim 15 is rejected for the reasons set forth for claim 1.” (Office Action at para. no. 5, page 7). For the reasons set forth above with

Response

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respect to independent claim 1, Biliris and Jones do not teach or suggest the above-quoted limitation of independent claim 15.

In view of the above, independent claim 15 is not taught or suggested by Biliris and Jones, either alone, or in combination. Applicant respectfully requests removal of the rejection of claim 15 under 35 U.S.C. §103(a), and requests allowance of this claim.

Dependent claim 16 further defines patentably distinct claim 15, is further distinguishable over the cited references, and is believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claim 16 under 35 U.S.C. §103(a), and requests allowance of this claim.

Independent claim 18 includes the limitations “determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company’s directory” and “adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company.” The Examiner stated that “claim 18 is rejected for the reasons set forth for claim 1.” (Office Action at para. no. 5, page 8). For the reasons set forth above with respect to independent claim 1, Biliris and Jones do not teach or suggest the above-quoted limitations of independent claim 18.

In view of the above, independent claim 18 is not taught or suggested by Biliris and Jones, either alone, or in combination. Applicant respectfully requests removal of the rejection of claim 18 under 35 U.S.C. §103(a), and requests allowance of this claim.

Dependent claims 20 and 21 further define patentably distinct claim 18, are further distinguishable over the cited references, and are believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claims 20 and 21 under 35 U.S.C. §103(a), and requests allowance of these claims.

The Examiner rejected claims 5, 6, and 14 under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 1 above, and further in view of Joseph et al., U.S. Patent No. 5,761,415 (“Joseph”). Dependent claims 5, 6, and 14 further define patentably distinct claim 1, are further distinguishable over the cited references, and are believed to be allowable over the cited prior art. Applicant respectfully requests removal

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of the rejection of claims 5, 6, and 14 under 35 U.S.C. §103(a), and requests allowance of these claims.

The Examiner rejected claims 10 and 11 under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 7 above, and further in view of Arnold, U.S. Patent No. 6,275,848 ("Arnold"). Dependent claims 10 and 11 further define patentably distinct claim 1, are further distinguishable over the cited references, and are believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claims 10 and 11 under 35 U.S.C. §103(a), and requests allowance of these claims.

The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Jones as applied to claim 7 above, and further in view of Shaw et al., U.S. Patent No. 6,247,045 ("Shaw"). Dependent claim 13 further defines patentably distinct claim 1, is further distinguishable over the cited references, and is believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claim 13 under 35 U.S.C. §103(a), and requests allowance of this claim.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1, 3-7, 9-16, 18, 20, and 21 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1, 3-7, 9-16, 18, 20, and 21 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Jeff D. Limon at Telephone No. (541) 715-5979, Facsimile No. (541) 715-8581 or Jeff A. Holmen at Telephone No. (612) 573-0178, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

Response

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 26th day of October, 2005.

By: 

Name Jeff A. Holmen